

Application No. 10/691,750
Amendment dated April 20, 2005
Reply to Office Action of October 21, 2005

REMARKS

This amendment is submitted in response to the Official Action mailed October 21, 2004. In view of the above amendments to the specification and claims, the enclosed Terminal Disclaimer, and the following remarks, reconsideration by the Examiner and allowance of the application is respectfully requested.

Claims 1, 16, 18 and 24 have been amended to more particularly point out and distinctly claim the subject matter of the invention. In particular, claims 16 and 24 have been amended to correct obvious typographical errors. Claims 1 and 18 have been amended to replace the polymer structure with a more legible structure that excludes the variable "N." Claim 18 has also been amended to correct a typographical error and to clarify that g is greater than zero but less than one. These amendments do not introduce new matter.

For reasons which are submitted below, the claims are believed to be in condition for allowance. The amendments and Terminal Disclaimer are believed to resolve the concerns raised by the Examiner. Accordingly, reconsideration is respectfully requested.

Turning to the Official Action, claims 1 – 34 were rejected for provisional obviousness-type double patenting in view of certain claims of co-pending U.S. Patent Application Serial Nos. 10/288,076, 10/691,749 and 10/796,847. This rejection is respectfully traversed for the following reasons.

U.S. Patent Application Serial Nos. 10/288,076, 10/691,749 and 10/796,847 have all been abandoned, rendering this rejection moot. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Next, claims 1 – 34 were rejected for obviousness-type double patenting in view of claims 1 -37 of U.S. Patent No. 6,602,497. According to the Examiner, the fabrication of the polymers of the present invention into radio-opaque medical devices would be obvious from

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the claims of this patent. The Examiner indicated that this rejection could be overcome with the timely filing of a Terminal Disclaimer. This rejection is respectfully traversed in view of the enclosed Terminal Disclaimer for the following reasons.

Applicants do not concede the correctness of the Examiner's position. However, because the filing of a Terminal Disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection nor an estoppel (see, MPEP §804.02 citing Quad Environmental technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991)), enclosed herewith is a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) and disclaiming the term of any patent issuing on the present application extending beyond the term of the cited patent. In view of the enclosed Terminal Disclaimer, reconsideration by the Examiner and withdrawal of this rejection is respectfully requested.

Next, Claims 1 – 34 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter applicants regard as the invention. The Examiner considered the claims to be ambiguous because the variable "N" in the formulae of independent claims 1 and 18 was undefined in the specification. The Examiner also considered claim 18 to be ambiguous because "g" was interpreted as encompassing negative values "less than one." This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

The variable "N" in the Formulae of independent claims 1 and 18 is recognized by those of ordinary skill in the polymer art as indicating that the subject matter within the brackets was a monomeric repeating unit. Because deleting "N" does not change the depiction of the bracketed material as a monomeric unit applicants have deleted "N" from both formulae in each independent claim. By amending claims 1 and 18 in this manner this portion of the rejection of claims 1 – 34 as indefinite has been overcome.

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Claim 18 has also been amended to clarify that “g” is greater than zero but less than one. By amending claim 18 in this manner, this portion of the rejection under 35 U.S.C, §112, second paragraph has been overcome.

In view of the above claim amendments, reconsideration by the Examiner and withdrawal of the rejection of claims 1 – 34 under 35 U.S.C, §112, second paragraph is respectfully requested.

The Examiner objected to the specification because the formulae at page 10, lines 11 and 12 and page 16, line 15 were difficult to read, and the heading over the description of FIG.1 stated, “Best Modes of Carrying Out the Invention.” This objection is respectfully traversed in view of the foregoing amendments to the specification.

In particular, the illegible formulae identified by the Examiner have been replaced with more legible structures. The incorrect section heading has been replaced with the correct heading. In view of the amendments to the specification, reconsideration by the Examiner and withdrawal of this objection is respectfully requested.

Finally, the Examiner requested that the incorrect spelling of “independently” in claim 18 be corrected. Claim 18 has been amended to correct this error. Other typographical errors in claims 16 and 24 have also been corrected.

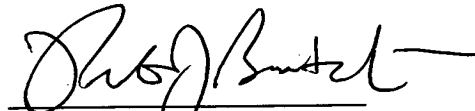
In view of the above amendments to the specification and claims, the enclosed Terminal Disclaimer and the foregoing remarks, this application is now in condition for allowance. Reconsideration is respectfully requested. However, the Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

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Finally, if there are any additional charges in connection with this response, the Examiner is authorized to charge applicant's deposit account number 19-5425 therefor.

Respectfully submitted,

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